

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TAMMY L. MAVER

Appeal No. 1997-1807
Application No. 08/395,248

ON BRIEF

Before JOHN D. SMITH, GARRIS, and KRATZ, Administrative Patent Judges.

KRATZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 10-15, which are all of the claims pending in this application.¹

¹ We note that proposed amendments to the claims presented in Appendix 2 of the brief have not been entered by the

BACKGROUND

At the outset, we note that Patent and Trademark Office (PTO) records indicate that the present application was filed on February 27, 1995, as a divisional of U.S. Application No. 08/167,385, which parent application was filed on December 15, 1993. Also, copending and related Application No. 08/394,935 was filed on February 27, 1995, as a continuation of the above-noted parent application. The above-noted related and copending Application No. 08/394,935 is also before us on appeal (Appeal No. 1997-1748).

Appellant's invention relates to a method of applying a coating to a chalky substrate with an alleged improved adhesion via the blending of a macromolecular aqueous dispersion with an acid-functional alkali-soluble polymer and an aminosilane compound. The aminosilane reduces the acid functionality of the acid-functional alkali-soluble polymer. The product paint/coating of the claimed method is also claimed. An understanding of the invention can be derived from a reading of exemplary claim 10, which is reproduced

examiner (answer, page 4) and hence those proffered amended claims are not before us for review in this appeal.

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below.

A method for improving the adhesion of a coating to chalky substrates comprising combining a macromolecular aqueous dispersion with an acid-functional alkali-soluble polymer to form a blend composition, said polymer having its acid functionality neutralized by an aminosilane and applying the coating of said blend composition to a chalky substrate.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Calhoun	5,399,612	Mar. 21,
		1995 ²

Morino et al. (Morino) ³	03-064305	Mar. 19,
		1991
(Laid-open Japanese Patent Application)		

Claims 10-15 stand rejected under 35 U.S.C. § 103 as being unpatentable over Calhoun in view of Morino.

OPINION

Upon a careful review of the opposing arguments advanced

² The earliest effective filing date (Dec. 20, 1990) relied on by examiner and consequent availability of this reference as prior art under 35 U.S.C. § 102(e) has not been specifically disputed by appellant. See Notice of References Cited (Form PTO-892, Paper No. 4) and related U.S. Application Data listed on the Calhoun patent.

³ Our reference to Morino in this decision is to the resubmitted English translation of record filed on September 21, 1995.

by the examiner in the answer and appellant in the brief in support of their respective positions, we conclude that the examiner has not established a *prima facie* case of obviousness for the claimed subject matter.⁴

Accordingly, we will not sustain the examiner's § 103 rejection.

Calhoun (column 2, line 58 through column 3, line 44) teaches that a blended polymeric composition containing at least one acid-functional vinyl polymer and at least one amino-functional siloxane polymer may be used as a quasi-crosslinked coating for various substrates. Calhoun (column 3, line 47 through column 6, line 28) further teaches that: (1) the amino-functional polysiloxane employed is water-insoluble albeit the blended polymer composition is soluble or dispersible in water and (2) an alkali or basic ingredient such as a volatile amine or ammonia is included in the composition to prevent reaction of the siloxane with the acid-functional moieties of the vinyl polymer. Morino (pages

⁴ We note that it is the examiner who bears the initial burden of presenting a *prima facie* case of obviousness in rejecting claims under 35 U.S.C. § 103. See *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993).

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1 and 2) discloses a silane-modified macromolecular dispersion for use in a coating material that adheres to silicate glass. The silane is described as water soluble (Morino, page 6).

According to the examiner (answer, page 4),

[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to use the aminosilanes of JP '305 in Calhoun '612 and expect them to function equivalently to produce the claimed method of combining the components of the blend composition for applying the blend coating to chalky substrates to improve adhesion. Amino silanes are known adhesion promoting agents.

The difficulty we have with the examiner's stated position stems, in part, from the fact that the examiner has not pointed to any particularized teaching of either of the applied references which would have suggested that the addition of the silane of Morino (JP '305) to Calhoun would function to improve adherence to chalky substrates as posited by the examiner as a basis for adding or substituting the silane of Morino for one or more of the ingredients of the composition of Calhoun and applying such a modified composition to a chalky substrate. Nor has the examiner furnished any other convincing rationale for the proposed modification of Calhoun including a detailed explanation as to

how any such proposed modification would have resulted in the claimed method or a product blend coating corresponding to appellant's coating. We specifically note that the examiner has not offered any other basis in the answer for explaining how the applied references may have rendered the product-by-process claims 11 and 15 unpatentable.

Additionally, the examiner has not convincingly explained in the answer where the motivation may be found in the combined teachings of the references to support the notion of "function equivalently" as a basis for modifying Calhoun as proposed. In this regard, we note that the showing of the teaching or motivation to combine prior art references must be clear and particular. *See In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Here, the examiner has failed to point to convincing evidence of a suggestion from the prior art, the knowledge of one of ordinary skill in the art, or the nature of the problem itself. *See In re Dembiczak, supra*.

For the foregoing reasons and those set forth in appellant's brief, we determine that the examiner has not

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established a *prima facie* case of obviousness. Consequently, on this record, we are constrained to reverse the examiner's rejection of the claims on appeal under 35 U.S.C. § 103 as unpatentable over Calhoun in view of Morino.

CONCLUSION

To summarize, the decision of the examiner to reject the appealed claims under 35 U.S.C. § 103 as stated in the answer is reversed.

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REVERSED

JOHN D. SMITH)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
BRADLEY R. GARRIS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
PETER F. KRATZ)	
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APPEAL NO. - JUDGE KRATZ
APPLICATION NO.

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APJ

DECISION: **ED**

Prepared By:

DRAFT TYPED: 28 Feb 01

FINAL TYPED: